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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,778	10/22/2003	Naoki Abe	CHA920030025US1	1597
45095 7590 12/11/2009 HOFFMAN WARNICK LLC 75 STATE ST 14 FL ALBANY, NY 12207				
EXAMINER MURDOUGH, JOSHUA A				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 12/11/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary

Application No.

10/690,778

Applicant(s)

ABE ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-37 is/are pending in the application.
- 4a) Of the above claim(s) 12-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 C.F.R. § 1.114

1. ***Acknowledgements*** A request for continued examination ("RCE") under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application on 16 September 2009, which was after a final rejection. Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's submission filed on 4 August 2009 has been entered.

Acknowledgements

2. This action is responsive to Applicants' above noted RCE and the amendments received 4 August 2009.
3. This action has been assigned paper number 20091204 for reference purposes only.
4. Claims 1-3, 5-37 are pending.
5. Claims 12-37 were previously withdrawn and remain withdrawn.
6. Claims 1-3 and 5-11 have been examined.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2, 3, 5, and 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claims 2, 3, and 5 recite the limitation "[t]he system of claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. There are three systems recited in claim 1: "[a] system for detecting fraudulent transactions," "a security system," and "an analysis system." Because there are multiple systems that "the system of claim 1" could be referring to, one of ordinary skill in the art would not be able to ascertain the metes and bounds of claims 2, 3, and 5. For purposes of applying the prior art only, the Examiner has interpreted "the system of claim 1" as referring to the "system for detecting fraudulent transactions."
10. Claim 10 recites "the SDPU prevents observation...selected" which renders the claim indefinite. It is not understood who is prevented from observing. If a computer programmer is debugging the software, can they observe which algorithm is selected? It is the Examiner's position that this is not Applicants' intent. Instead, the Examiner's position is that Applicants' intend to prevent parties who may be attempting to execute a fraudulent transaction from knowing which algorithm is selected.
11. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 and 5-11 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ziegler (US 2004/0044739) in view of Douceur (US 2004/0060042) further in view of Tochikubo (US 7,096,357).

14. As to claims 1, 3, 6-9, and 11, Ziegler shows:

- a. A system for detecting fraudulent transactions, comprising:
- b. an interface **102** for inputting transaction data (via keyboard 108 and mouse 110) and outputting analysis results (on monitor 104); and
- c. a tamper-resistant ("tamper proof server," [0112]) secure data processing unit (SDPU) **124**, wherein the SDPU includes:
- d. a security system (HSM) that can restrict access to data and program execution [0232];
- e. an analysis system for analyzing inputted transactions [0006];
- f. a plurality of surveillance algorithms ("several securing functions," [0054] wherein the plurality of surveillance algorithms make a determination regarding a probability that inputted transactions are fraudulent ("if fraud is detected," Id.)

15. Zeigler does not expressly show:

- g. a selection program for selecting at each of a sequence of random times a different surveillance algorithm to be used by the analysis system;
 - h. the selection program utilizes a random selection program for selecting surveillance algorithms;
 - i. measuring a randomness of the algorithm selection process using a technique selected from the group consisting of correlation and entropy measures; and
 - j. issuing an alert if the randomness goes under a predetermined threshold;
 - k. the surveillance algorithms are stored in an encrypted database; and
 - l. the further step of decrypting the selected surveillance algorithm..
16. However, Douceur shows random selection [0050] with a predefined correlation coefficient ("rho," [0067]) and the calculation of the correlation coefficient from already generated random values [0074]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Ziegler to add the calculations and selection method of Douceur so that a comparison of the predefined rho and the calculated rho would trigger an alert as taught by Ziegler if the difference exceeded a threshold. The random selection of algorithms would allow for a more secure system through the use of differing algorithms but with efficiency near that of just using one algorithm because only one is in use at a time. The alert would allow for a notice that the system is not operating properly or has become too predictable. If the system becomes predictable, the added security of the rotating algorithms is diminished.
17. The Zeigler/Douceur combination does not expressly show:
- m. the surveillance algorithms are stored in an encrypted database; and

- n. the further step of decrypting the selected surveillance algorithm..
18. However, Tochikubo teaches an encrypted storage **13** of algorithms (C 4, LL 40-44) which requires that the algorithms be decrypted before use. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Zeigler to store the securing functions in an encrypted database and decrypt them before use in order to ensure that the algorithms cannot be tampered with.
19. As to claim 2, Zeigler further shows:
- o. the SDPU further includes an algorithm performance system **1102** that assists the selection program in selecting surveillance algorithms [0062].
20. As to claim 5, Zeigler further shows:
- p. the security system includes an encryption system for encrypting and decrypting data [0038].
21. As to claim 10, Zeigler further shows:
- q. the SDPU prevents observation of which surveillance algorithm is selected (observation of the execution of the software would be an unauthorized access [0232]).

Claim Interpretation

22. The Examiner hereby adopts the following interpretations under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d

1023, 1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these interpretations are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- r. **Can:** "1...f : be inherently able or designed to." Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.
- s. **For:** "1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal" Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

23. Applicant's arguments with respect to claims 1-3 and 5-11 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

¹ While most definitions are cited because these terms are found in the claims, the Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

25. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621